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| 10/568,416  | 02/14/2006  | Seiichi Murakami     | 060118              | 7562             |
| 23850 7590 12/01/2009<br>KRATZ, QUINTOS & HANSON, LLP<br>1420 K Street, N.W.<br>Suite 400<br>WASHINGTON, DC 20005 |             |                      |                     |                  |
| EXAMINER  |             |                      |                     |                  |
| MORRIS, JOHN J  |             |                      |                     |                  |
| ART UNIT  |             | PAPER NUMBER         |                     |                  |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/568,416

**Applicant(s)**

MURAKAMI, SEIICHI

**Examiner**

John Morris

**Art Unit**

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Arguments***

Applicant's arguments with respect to claim 1-9 have been considered but are moot in view of the new ground(s) of rejection.

In regards to claim 8 the applicant argues that the examiner does not reference to any holding members that are U-shaped, the examiner respectfully disagrees. Takashi teaches U-shaped holding members (Takashi, figure 9, item 13). Here the top portion of the holding member is a distinctive U shape.

In regards to claim 1, the applicant argues that the conductive paste taught by Furuhashi is not adhesive and is not in direct contact with at least on peripheral edge. The examiner respectfully disagrees. The conductive paste and the double sided tape of Furuhashi make up the holding member (Furuhashi, figure 2, items 8C, 8CH, 8D, 8DH). The applicant also argues that the conductive paste is not adhesive since it is not made up of flour and water. The Merriam-Webster's dictionary defines paste as " 2 : a soft plastic mixture or composition: as a : a preparation usually of flour or starch and water used as an adhesive or a vehicle for mordant or color b : clay or a clay mixture used in making pottery or porcelain". It stats that paste is *usually* made of water and flour, but it does not limit it to only water and flower. The applicant also argues that the past is not in direct contact with at least on peripheral edge, the examiner respectfully disagrees. The paste is in direct contact with the edge of the double sided tape (figure 2, item, 8C and 8D) and the double sided tape, which is part of the holding member, is in direct contact with the edge of the two substrates (figure 2).

The applicant argues that the Furuhashi does not teach lead-out terminals on both substrates. The examiner agrees, however, the argument is moot upon new grounds of rejection. Noda teaches a plurality of lead-out terminals being connected to the electrodes through surrounding circuits extending to the peripheral edges of the first substrate and the second substrate, the lead-out terminals each being arranged on the opposing surfaces of the first substrate and the second substrate (Noda, figure 2, items 4a-4d).

The applicant argues that Furuhashi does not teach a notch portion, the examiner respectfully disagrees. Furuhashi teaches a notch portion in figure 2, item 10. Here you can see a notch portion which will be in direct contact with the holding member 8C.

The applicant would like the examiner to produce a reference for the grooves recited in claim 4. Nagahata et al. (JP 09045438) teaches grooves for the holding members (Sato, figure 4, item 10).

The applicant also argues that Takashi does not teach “inserted between the transparent first substrate and the second substrate”. The examiner notes that Takashi is combined with Furuhashi which teaches a transparent substrate.

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2, 3, 5, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Furuhashi et al. (US Pub# 20020000979 A1/ or "*Furuhashi*" *hereinafter*) in view of Noda et al. (JP 09-050731/ or "*Noda*" *hereinafter*).

For **claim 1**, Furuhashi teaches a transparent first substrate and a second substrate each having a transparent electro-conductive layer on one surface thereof, the transparent first substrate and the second substrate being arranged with a predetermined interval between each other in such a manner that the transparent electro-conductive layers are facing each other, and each transparent electro-conductive layer including a respective pair of electrodes disposed on each end (Furuhashi, page 5 paragraph [0101] - page 6 paragraph[0112], figure 2). Furuhashi teaches a plurality of holding members in direct contact with at least one peripheral edge for holding the peripheral edges of the transparent first substrate, the holding members being formed of an electro-conductive material and formed so that each of the portions inserted between the transparent first substrate and the second substrate is in contact with at least on respective lead-out terminal of either the first or second substrate (Furuhashi, page 5 paragraph [0101] - page 6 paragraph [0112], figure 2 items 8, 1, 2, 11a, 11c, and 12).

Furuhashi does not teach lead-out terminals on both substrates; however, in the same field of endeavor; Noda teaches a plurality of lead-out terminals being connected to the electrodes through surrounding circuits extending to the peripheral edges of the first substrate and the second substrate, the lead-out terminals each being arranged on the

opposing surfaces of the first substrate and the second substrate (Noda, figure 2, items 4a-4d). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Furuhashi with Noda because the addition would allow for a bigger screen since the terminals are divided between two substrates, instead of all being on one substrate.

For **claim 2**, configuring the thickness of the portions of the holding members inserted between the transparent first substrate and the second substrate to 0.5 to 2 times the space between the transparent first substrate and the second substrate is an obvious matter of design choice. This is so because such a modification would only require a mere change of components. Furuhashi teaches adhesive material between the two substrates (Furuhashi, figure 2); this material could easily be modified to increase or decrease the space between. Furuhashi also teaches spacers in between the substrates to prevent the two substrates from touching each other (Furuhashi, figure 2); these spacers can also be configured to increase or decrease the space between the substrates.

For **claim 3**, Furuhashi teaches a notched portion that is contact with the holding members (Furuhashi, figure 2, items 8c).

For **claim 5**, Furuhashi teaches the first substrate as a fixed substrate (Furuhashi, figure 2, page 8, paragraph [0139]).

For **claim 6**, Furuhashi teaches a transparent first substrate and a second substrate each having a transparent electro-conductive layer on one surface thereof, the transparent first substrate and the second substrate being arranged with a predetermined interval between each other in such a manner that the transparent electro-conductive layers are facing each other, and each transparent electro-conductive layer having a pair of electrodes disposed on each end (Furuhashi, page 5 paragraph [0101] - page 6 paragraph[0112], figure 2). Furuhashi also teaches a plurality of lead-out terminals being connected to the electrodes through surrounding circuits formed on the peripheral edges of the first substrate and the second substrate, the lead-out terminals each being arranged on the opposing surfaces of the first substrate and the second substrate (Furuhashi, page 5 paragraph [0101] - page 6 paragraph[0112], figure 2). Furuhashi teaches a plurality of holding members for holding the peripheral edges of the transparent first substrate, the holding members being formed of an electro-conductive material and formed so that each of the portions inserted between the transparent first substrate and the second substrate is in direct contact with each lead-out terminal whereby the apparatus and the lead-out terminals are electrically coupled (Furuhashi, page 5 paragraph [0101] - page 6 paragraph [0112], figure 2). Furuhashi also teaches that this touch panel being disposed on the display surface side of the display apparatus, and the holding members being in contact with the connecting terminals (Furuhashi, figure 1).

For **claim 7**, Furuhashi teaches the holding members hold at least on eperipheral edge of the transparent first substrate (Furuhashi, figure 2, items 8, 1, and 2).

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Furuhashi et al. (US Pub# 20020000979 A1/ or "*Furuhashi*" *hereinafter*) in view of Takashi (JP- 2000187237) and Nagahata et al. (JP 09045438).

For **claim 4**, Furuhashi does not teach groove portions in the surface of the substrate; however, in the same field of endeavor, Takashi teaches holding plates to hold the substrates together (Takashi, abstract). It would have been obvious to one skill in the art at the time of the invention to modify Furuhashi with Takashi because both are touch panels and using the holding members provide a more secure way to hold the substrates together.

Takashi does not teach grooves to hold the U-shaped holding members in place; however, in the same field of endeavor, Nagahata teaches grooves for the holding members (Nagahata, figure 4, item 10). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Furuhashi and Takashi with Nagahata because the addition would ensure the holding members do not slide out of place.

4. Claims 8, and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Furuhashi et al. (US Pub# 20020000979 A1/ or "*Furuhashi*" *hereinafter*) in view of Takashi (JP- 2000187237).



For **claim 8**, Furuhashi does not teach a U-shaped holding member; however, in the same field of endeavor, Takashi teaches a U-shaped holding member and an interior of the U overlaps the at least one peripheral edge of the transparent first substrate (Takashi, abstract). It would have been obvious to one skill in the art at the time of the invention to modify Furuhashi with Takashi because both are touch panels and using the holding members provide a more secure way to hold the substrates together

For **claim 9**, Takashi teaches U-shaped holding members, where the interior of the U overlaps the at least one peripheral edge and the connecting terminals are in direct contact with a leg of the U-shape (Takashi, abstract). It would have been obvious to one skill in the art at the time of the invention to modify Furuhashi with Takashi because both are touch panels and using the holding members provide a more secure way to hold the substrates together

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Morris whose telephone number is (571)270-7171. The examiner can normally be reached on Monday-Friday, 7am-3pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amr Awad can be reached on 571-272-7764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Amr Awad/  
Supervisory Patent Examiner, Art Unit 2629